2. REMARKS / DISCUSSION OF ISSUES

Claims 1-3, 6-8 and 10 are pending in the application. Claims 1 and 8 are independent claims. Unless indicated to the contrary, claims are amended for non-statutory reasons, such as to delete European-style claim phraseology. No new matter is added.

Rejection under 35 U.S.C. § 112, ¶ 2

Claim 7 was rejected under this section of the Code for alleged vagueness. In particular, the Examiner asserts that the featured electrodes (plural) are vague because a 'single' electrode is claimed. First, Applicants note that claim 1 features an electrode; and does not include the term single.

In *AbTox, Inc., v. Excitron, Inc.*, 122 F.3d 1019 (1997) the CAFC noted that "this Court has encountered 'a' or 'an' in patent claims on several occasions. patent claim parlance also recognizes that an article can carry the meaning of 'one or more,' for example in a claim using the transitional phrase 'comprising.' *See North Am. Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 1575-76, 28 U.S.P.Q.2D (BNA) 1333, 1336 (Fed. Cir. 1993) (acknowledging that patent parlance construes 'a' to connote 'one or more,' yet holding that 'there is no indication in the patent specification that the inventors here intended it to have other than its normal singular meaning') a **single** unitary [element] or extends to encompass a device with multiple [elements].' *Id.* at 1024, 43 U.S.P.Q.2D (BNA) at 1548. Moreover, standing alone, a disclosure of a preferred or exemplary embodiment encompassing a singular element does not disclaim a **plural** embodiment. 'Although the specifications may well indicate that certain embodiments are preferred, particular embodiments appearing in a specification will not be read into the claims when the claim language is broader than such embodiments.' *Electro Med. Sys., S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1054, 32 U.S.P.Q.2D (BNA) 1017, 1021 (Fed. Cir. 1994). Thus, as the rule dictates, when the claim language or context calls for further inquiry, this court consults the written description for a clear intent to limit the invention to a singular embodiment." (Emphasis provided in each instance.)

A review of the filed application does not reveal the clear intent on the part of Applicants to be limited to a single electrode. Therefore, the term 'an electrode' means 'one or more electrodes' and claims 1 and 7 are therefore consistent with one another.

For at least the reasons set forth above, Applicants respectfully demur the rejection under 35 U.S.C. § 112, ¶ 2.

Rejections Under 35 U.S.C. § 102

1. Claims 1-5 and 8-10 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by *Hamilton* (U.S. Patent 5,978,693). For at least the reasons provided herein, Applicants respectfully submit that the pending claims are patentable over the applied art.

Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen,* 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.,* 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.,* 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

i. Columns 3 and 6 of *Hamilton*

Claim 1 is drawn to a wearable device having an electrode. The electrode features

"...motion artifact detection means having a thin film pressure sensor arranged on a rear surface of the electrode, said rear surface being opposite the contact surface...

Claim 8 is drawn to an electrode assembly and includes a similar feature.

The Examiner alleges:

> Applicant's arguments filed August 1, 2007 have been fully considered but they are not persuasive. The Hamilton et al reference details that thin film pressure sensors can be employed as an equivalent to optical sensors for detecting the normal component. Applicant's attention is directed to column 3, lines 41-61 and column 6, lines 31-50. Accordingly, the above rejections are still deemed to be proper.

A review of the noted portions of *Hamilton* fails to disclose the noted features of claim 1. While the reference does disclose the use of strain gauges mounted on a resilient strip in the portion of column 3 relied upon, there is no disclosure of the *a thin film pressure sensor arranged on a rear surface of the electrode, said rear surface being opposite the contact surface* as specifically recited in claim 1.

The disclosure in *Hamilton* at column 6, lines 31-50 describes strain gauges used to monitor the foam pad 12 as it stretches and contracts. A foil strain gauge is employed and the reference describes the requirement for its elastic modulus to be not so large to avoid masking the stretching and contracting of the foam pad 12. However there is no disclosure of a *thin film pressure sensor arranged on a rear surface of the electrode, said rear surface being opposite the contact surface* as specifically recited in claim 1. To wit, a review of Figs. 2 and 3 reveal that the strain gauge 32 is disposed over the foam pad 12 and the electrode 22 spaced apart. Thus, the portions of the applied art fail to disclose the noted features of claim 1. By similar analysis, the same conclusion can be reach regarding claim 8.

ii. Figs. 8 and 9 of *Hamilton*

The Office Action directs Applicants to the description of Figs. 8 and 9, alleging anticipating disclosure of claims 1-3 and 8. Applicants respectfully disagree.

The description of Fig. 8 fails to reveal the *thin film pressure sensor arranged on a rear surface of the electrode, said rear surface being opposite the contact surface.* Rather, a fiber optic sensor 212 and an electrode 206 are provided with a foam pad 202 to provide a skin mounted physiological recording electrode assembly 200. There is no arrangement as featured in claim 1. (Kindly refer to column 7, line 65-clumn 8, line 21 of *Hamilton* for support for Applicants' position.)

The description of Fig. 9 is of a skin mounted physiological recording electrode assembly 300 and includes a foam pad 302, a resilient strip 316, one or more strain gauges 322, and an electrode 308 that passes through a passage 306 in the foam pad. The description of Fig. 9 nonetheless fails to reveal the *thin film pressure sensor arranged on a rear surface of the electrode, said rear surface being opposite the contact surface.* There is no arrangement as featured in claim 1. (Kindly refer to column 8, lines 21-56 of *Hamilton* for support for Applicants' position.)

For at least the reasons set forth above, Applicants respectfully submit that *Hamilton* fails to disclose at least one feature of independent claims 1 and 8. As such, a *prima facie* case of anticipation cannot be established based thereon. Thus, claims 1 and 8 are patentable over the applied art. Moreover, dependent claims 2-3 and 6-7, which depend from claim 1, are patentable for at least the same reasons.

Rejections Under 35 U.S.C. § 103

The rejection of claims 6 and 7 has been considered. These claims depend from claim 1 and are patentable for at least the reasons set forth above.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

_/William S. Francos/_____
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